

REMARKS AND REQUEST FOR RECONSIDERATION

Responsive to the Restriction Requirement of August 10, 2009, Applicants provisionally elect with traverse to prosecute claims 1-23 and 37-39, identified by the examiner as Group 1, and drawn to a method of preparing DNA fragments prepared by the method.

Restriction has been required from among the following three (3) identified claim groupings:

- 1) Group I: claims 1-23 and 37-39, drawn to a method of preparing DNA fragments and fragments prepared by the method;
- 2) Group II: claims 24, 28, and 31-35, drawn to a cDNA chip and kit; and
- 3) Group III: claims 27 and 36, drawn to a method of hybridizing nucleic acids.

Restriction has been required under PCT Rules 13.1 and 13.2, ostensibly because the inventions of Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1, and lack the same or special technical features under PCT Rule 13.2. Specifically, the examiner considers that the lack of a 'special' technical feature is due to the lack of a contribution over the prior art in view of Uemori et al (U.S. 2003/0186312) and Hefti et al (U.S. 6,287,776).

However, Applicants respectfully urge that the requirement for restriction is unwarranted and improper for several reasons.

First, it is noted that no objection based upon 'lack of unity' was raised during the International Phase of the corresponding PCT application. This is considered important since the same standards for 'unity' of 'lack of unity' must apply in all PCT signatory countries when any PCT application enters the national phase.

Second, in the present application there clearly is 'unity' of invention. A principle objective of the present invention is to provide short cDNA fragments representative of an entire genome or transcriptome to be analyzed by DNA hybridization. The 'same or special technical feature' of the claims is a double-stranded (ds) DNA adapter AA' containing the first bases only (not the entire sequence) of a type IIS restriction enzyme (E2 enzyme) recognition sequence.

This adapter is used to isolate a subset of short DNA fragments which can reconstitute the entire E2 enzyme recognition site upon ligation with the adapter AA' (see steps b) and c) of method claims 1 to 20). The adapter sequence corresponds to one end of the short DNA fragments of claims 21-23. The adapter sequences is also present in the DNA chip which comprises the short DNA fragment (claim 24), in the hybridization which uses the short DNA fragment/DNA chip (claims 27 and 36) as well as in the kit of claims 28 and 31-35.

Clearly, this 'same or special technical feature' is neither disclosed nor suggested by either reference cited by the examiner.

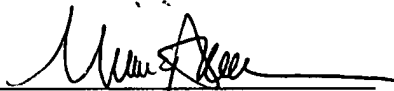
In particular, Uemore et al (U.S. 2003/0186312) merely discloses a kit containing a DNA polymerase. Hefti et al (U.S. 6,287,776) merely discloses a DNA chip containing cDNA fragments.

Hence, in view of all of the above, it is believed that the requirement for restriction based upon 'lack of unity' is without basis and should be vacated, and that all claimed aspects of the present application should proceed to examination without further delay.

Favorable consideration is earnestly solicited.

Respectfully submitted,

THE NATH LAW GROUP



William E. Beaumont, Reg. No. 30,996
Customer No. 20529

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THE NATH LAW GROUP

112 S. West Street, Alexandria, VA 22314
TEL: (703) 548-6284; FAX: (703) 683-8396
WEB/le